



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/647,207

08/26/2003

Ryoji Watanabe

116872

1938

7590
OLIFF & BERRIDGE
P. O. BOX 19928
ALEXANDRIA, VA 22320

10/07/2008

EXAMINER

GETANEH, MESFIN S

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

10/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/647,207	Applicant(s) WATANABE ET AL.	
	Examiner MESFIN GETANEH	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed September 22, 2008 to the original filed August 26, 2003.
2. Claims 1-10 are pending in this application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 22, 2008 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (US Pub 20020170973) in view of Minami et al. here in after Minami (US Pat 7,048,194).

Re claim 1, Teraura teaches an image forming system (copy machine with a facsimile function as shown in FIG. 2) comprising:

an image display member (Printing paper 13 with RFID tag 14 as shown in FIG. 3) on which an image is displayed (printing an image on a sheet of printing paper with an RFID tag [0008]); and

an image forming apparatus (FIG. 2), wherein:
the image display member includes:

a first parameter storage unit (RFID tag 14 as shown in FIG. 3, [0064]) stores a first parameter indicating a way to form the displayed image and a formation history of the displayed image and outputs the stored first parameter to an **external** (The personal computer transmits the printing command and data to the copy machine 1, [0081] and RFID tag stores data of the software transmitted from the personal computer 39, [0083]; The microprocessor 21 stores the received data in the EEPROM 24 in the memory circuit and modulates the data from the memory circuit and transmit the data through the antenna to a reader-writer, [0064]);

the image forming apparatus includes:

an image reading unit for reading the displayed image (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068]-[0069], [0085]);

a parameter reading unit for reading the output first parameter (the control circuit 29 in FIG. 5 controls the first reader-writer 15 to read the data in the RFID tag 14 [0087]); and

an image forming unit for forming the read image on the basis of the read first parameter on a recording **medium** (printing unit 11 in FIG. 5 prints image as determined by the control circuit 29 on a printing paper with RFID tag [0082], [0093]); and

a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium, wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up print mode and information indicating the value of n, where n is a positive integer.

Examiner interprets this part of the claim language to indicate requiring a parameter writing unit for writing at least the read first parameter and not necessarily both one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium.

Teraura teaches the third reader-writer 17 is provided to record data [0071] and the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 [0092].

However, the examiner also addresses this part of the claim language requiring both parameters.

Teraura does not explicitly teach **a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium,**

wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up print mode and information indicating the value of n, where n is a positive integer.

Minami teaches printing information includes paper-related information regarding, for example, the type and the size of the printing paper and setting-related information regarding the settings in a predetermined printing apparatus that performs printing with the printing paper (col. 6, line 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine the teachings of Teraura and Minami to cause information used for printing to be carried on a printing paper (Minami, col. 1, line 55-57).

Re claim 2, which further limits claim 1, wherein:

Teraura teaches the recording medium includes a second parameter storage unit for storing the first parameter written from the external and outputting the stored first parameter to the external; and (the control circuit 29 controls the third reader-writer 15 to store data in the RFID tag 14 to print it on printing paper with RFID tag [0087]).

the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 [0092].

Teraura does not explicitly teach the image forming apparatus includes a parameter writing unit for writing one of the read first parameter and a second

Art Unit: 2625

parameter containing a history updated in response to the image formation on the recording medium into the second parameter storage unit.

Examiner interprets this part of the claim language to indicate requiring a parameter writing unit for writing at least the read first parameter and not necessarily both one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium.

Teraura teaches the third reader-writer 17 is provided to record data [0071] and the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 [0092].

However, the examiner also addresses this part of the claim language requiring both parameters.

Teraura does not explicitly teach **a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium,**

wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up print mode and information indicating the value of n, where n is a positive integer.

Minami teaches printing information includes paper-related information regarding, for example, the type and the size of the printing paper and setting-related information regarding the settings in a predetermined printing apparatus that performs printing with the printing paper (col. 6, line 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine the teachings of Teraura and Minami to cause information used for printing to be carried on a printing paper (Minami, col. 1, line 55-57).

Re claim 3, an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

an image reading unit for reading an image displayed on an image display member (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068] and [0069]);

a parameter reading unit for reading a first parameter indicating at least one of a way to form the displayed image and a formation history of the displayed image from the image display **member** (the control circuit 29 in FIG. 5 controls the first reader-writer 15 to read the data in the RFID tag 14 [0087]);

an image forming unit for forming the read image on the basis of the read first parameter on a recording **medium** (printing unit 11 in FIG. 5 prints image as determined by the control circuit 29 on a printing paper with RFID tag [0082]); **and**

the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 **[0092]**.

Examiner interprets this part of the claim language to indicate requiring a parameter writing unit for writing at least the read first parameter and not necessarily both one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium.

Teraura teaches the third reader-writer 17 is provided to record data **[0071]** and the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 **[0092]**.

However, the examiner also addresses this part of the claim language requiring both parameters.

Teraura does not explicitly teach **a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium,**

wherein the history contained in the second parameter includes information indicating a previous printing of the image formed on the recording medium in an n-up print mode and information indicating the value of n, where n is a positive integer.

Minami teaches printing information includes paper-related information regarding, for example, the type and the size of the printing paper and setting-related information regarding the settings in a predetermined printing apparatus that performs printing with the printing paper (col. 6, line 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine the teachings of Teraura and Minami to cause information used for printing to be carried on a printing paper (Minami, col. 1, line 55-57).

Re claim 5, which further limits claim 3, wherein

Teraura does not explicitly teach the first parameter includes information indicating a mode for forming the displayed image on the recording medium, a size of the formed image, and number of the image formation.

Minami teaches printing information includes paper-related information regarding, for example, the type and the size of the printing paper and setting-related information regarding the settings in a predetermined printing apparatus that performs printing with the printing paper (col. 6, line 51-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine the teachings of Teraura and Minami to cause information used for printing to be carried on a printing paper (Minami, col. 1, line 55-57).

Re claim 7, a method for forming an image, the apparatus of claim 1 and claim 3 perform the method as claimed in claim 7.

Re claim 8, which further limits claim 7, the apparatus of claim 2 performs the method as claimed in claim 8.

Re claim 9, a computer program **encoded in a computer-readable medium when executed by the computer**, Control circuit 29, storing unit 33 in FIG. 5 of Teraura execute the method of claim 7.

Re claim 10, which further limits claim 9, Control circuit 29, storing unit 33 in FIG. 5 of Teraura execute the method of claim 8.

Response to Arguments

5. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MESFIN GETANEH whose telephone number is (571)270-3752. The examiner can normally be reached on 9:00AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mesfin Getaneh/
Patent Examiner
Au 2625

/Mark K Zimmerman/

Supervisory Patent Examiner, Art Unit 2625